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EXAMINER

PIAZZA CORCORAN, GLADYS JOSEFINA

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,109

Applicant(s)

BOUDOURIS ET AL.

Examiner

Gladys JP Corcoran

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-42, 45-60, 72, 75 and 77-80 is/are pending in the application.
- 4a) Of the above claim(s) 42 and 45-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-41, 60, 72, 75 and 77-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/7/05, 8/30/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

FINAL ACTION

Election/Restrictions

1. Claims 42, 45-59 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Election was made **without** traverse in the Paper filed December 11, 2003.

Specification

2. The disclosure is objected to because of the following informalities: The amendment to the Specification on page 22, line 24 recites "about 76 :m to about 305 :m" which should be --about 76 μ m to about 305 μ m--

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 77 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 77 recites that a magnetic field is applied to the magnetic layer "and maintaining said magnetic field until said magnetic layer cools". While there is support in the Specification for applying a magnetic field (Specification

pages 2 and 14), there is no support in the original Specification for maintaining the magnetic field until the magnetic layer cools.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-17, 22-32, 35, 38-41, 60, 72, 75, are rejected under 35 U.S.C. 103(a) as obvious over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al.

(US Patent No. 5,869,148) as further taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586).

Bielek discloses a process of forming a magnetic assembly (composite substrate 10) by providing a magnetic composition at an elevated temperature (extrusion coated) comprising about 75% to 95% (column 2, lines 41-59) of at least one magnetic material and about 5% to 25% of at least one thermoplastic polymer (column 2, lines 41-59), directly applying the magnetic composition (14) at an elevated temperature when it is pliable to a printable substrate layer (12) (extrusion coated; column 3, lines 19-27).

As to the limitation that the magnetic composition is a hot melt, the binders in Bielek are considered to include hot melt binders. Alternatively, Silverschotz is cited to show that it is known that the binders in such magnetic compositions are considered to be hot melt polymers (column 3, line 22). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming a magnetic assembly as shown by Bielek with a composition that is a hot melt, as the compositions cited in Bielek are considered to be hot melts and additionally since it is known to provide such compositions with hot melt binders as exemplified by Silverschotz.

As to the magnetic composition being applied at an elevated temperature, Bielek is considered to meet this limitation by disclosing the magnetic composition is applied by extrusion coating (column 3, lines 19-27). Optionally, the references Wade, Mueller, Yanulis are cited to show that it is conventionally known in the art that extrusion coated polymeric layers are applied at elevated temperatures. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly

as shown by Bielek by providing the magnetic composition at an elevated temperature as is conventionally known for extrusion coating of polymeric materials and as optionally further exemplified by Wade, Mueller, Yanulis.

As to claims 2 and 3, the extrusion coating of the magnetic composition layer on the printable substrate layer (12) in dimensions of thickness and width and length. As to claim 4, the magnetic assembly is subjected to a strong magnetic field sufficient to result in a permanent magnetic effect in the assembly (column 4, lines 1-5). As to claim 5, Bielek does not specifically disclose whether the assembly is at an elevated temperature while being subjected to the magnetic field, however, it is considered well known in the art to apply the magnetic field while the composition is at an elevated temperature and it would have been obvious to one of ordinary skill in the art to form the magnetic assembly in Bielek in such a conventional manner. As to claim 6, the magnetic assembly is at ambient temperature after it is produced. As to claim 7, the magnetizing step is accomplished after the applying step (column 4, lines 1-5). As to claim 8, the printable substrate is printed (column 2, lines 29-31; column 3, lines 24-27).

As to claim 9, Bielek does not specifically disclose the particular method steps after formation. However, it is considered well known in the art to form extrusion coated layers into a roll form after coating. For example, Wade, Mueller, and Yanulis all show examples in the art of extrusion coating polymeric layers onto substrate layers in web form and then rolling into a roll. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the magnetic assembly as shown in Bielek

by rolling the coated layers into a roll form after extrusion coating as is considered conventional in the art and further exemplified by Wade, Mueller, and Yanulis.

As to claim 10, Bielek discloses finished products in sheet form and it would have been well within the purview of one of ordinary skill in the art to form the magnetic assembly into a sheet form, only the expected results would be attained.

As to claims 11, 12, 75, it is considered well known in the packaging arts to packaged groups items such as novelty items as disclosed by Bielek by stacking the items into a pad and binding by either adhesive (on one end for claim 75) or with shrink wrap. Only the expected results would be attained by employing such a well known and conventional packaging practice to the novelty items in Bielek for distribution.

As to claim 13, Bielek does not disclose the particular temperature at which the coating is extrusion coated, however, selecting the appropriate temperature is considered well within the purview of one of ordinary skill in the art and is only dependent upon the particular materials used, speed, thickness, etc. Furthermore, Yanulis shows it is known to extrude polymeric materials in the same temperature range as claimed (column 3, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly in Bielek by selecting the appropriate temperature of application in accordance with the materials selected as would have been well within the purview of one of ordinary skill in the art and is considered within the known ranges as exemplified by Yanulis.

As to claim 14, Bielek discloses extrusion coating as one example of coating the magnetic composition to the printable layer, however roll coating, gravure coating,

screen printing, and slot-die coating are considered well known equivalent alternative coating methods in the art. For example, Silverschotz discloses coating magnetic materials in the alternative forms (column 3, lines 59-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown by Bielek by well known and conventional coating application methods as are considered equivalent methods in the art to extrusion coating as exemplified by Silverschotz.

As to claim 15, Bielek discloses extrusion coating. As to claim 16, Bielek discloses using a ferrite as the magnetic material (column 2, lines 41-47). As to claim 17, these materials are considered conventional magnetic particles and well known in the art and it would have been well within the purview of one of ordinary skill in the art at the time of the invention to select any of the well known magnetic materials, only the expected results would be attained. As to claim 21, Bielek discloses the particular particle size (column 2, line 47). As to claims 22-24, Bielek discloses the particular coating thickness of the magnetic layer (column 3, lines 5-7). As to claims 25 and 28, the extrusion coated layer in Bielek is considered to be in the form of a ribbon with substantially the same width and length as the printable substrate layer. As to claims 26 and 27, it is considered conventional to press the extrusion coated layer to the substrate with a chill roll as exemplified by Wade, Mueller and/or Yanulis.

As to claims 29 and 40, Silverschotz discloses it is known in the art to apply magnetic compositions onto printable substrates in a discontinuous pattern (see figure 4 for example) in order to form a variety of different end products. It would have been

obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assemblies as shown by Bielek by applying the magnetic composition in a discontinuous pattern in order to form a variety of end products as shown by Silverschotz.

As to claim 30, Bielek discloses the printable substrate layer is plastic. Additionally, it is considered well known in the art to coat magnetic layers onto printable substrate layers made of a variety of materials including paper, metal, fabric, or plastic as exemplified by Silverschotz (column 2, line 63). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the magnetic assembly as shown by Bielek with a printable substrate layer made of paper, metal or fabric as well known alternatives to plastic as exemplified by Silverschotz.

As to claim 31, Bielek discloses treating the printable layer with a variety of well known coatings (column 2, lines 21-41). It is further noted that Silverchotz also discloses it is known in the art to treat the printable layer (column 3, lines 1-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown by Bielek by treating the printable substrate layer as is considered well known in the art and further exemplified by Silverschotz.

As to claims 32 and 35, Bielek discloses joining the magnetic layer to a release liner (18) and the step of removing the magnetic assembly from the release liner (column 3, lines 27-37). As to claim 38, Bielek discloses providing the magnetic composite as a variety of known novelty items. It is considered well known in the art that items such as reminders, business cards, greeting cards, postcards, labels,

advertisements, coupons, calendars, schedules, recipes, or promotional cards are considered novelty items in the art. Additionally, Silverchotz discloses magnetic assemblies of the claimed articles (column 7, line 49 to column 8, line 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown in Bielek into novelty items such as those claimed as is considered well known in the art and further exemplified by Silverschotz.

As to claims 39 and 41, the magnetic layer in Bielek is continuous with the printable layer and the magnetic layer and printable layer are of equivalent length and width. As to claim 72, all the limitations have been addressed with reference to claim 1 above.

As to claim 60, the limitations are met by the references as discussed above for claim 1. Additionally, Bielek discloses a process of forming a magnetic assembly (composite substrate 10) by extruding at an elevated temperature (extrusion coated) a magnetic composition (14) comprising about 70% to 95% (column 2, lines 41-59) of at least one magnetic material and about 5% to 30% of at least one thermoplastic polymer (column 2, lines 41-59), onto a printable substrate layer (12) (extrusion coated; column 3, lines 19-27). As to the particular thermoplastic polymers, Bielek discloses providing a variety of thermoplastic polymers polyolefins. As to the alternative polymers of natural rubbers, block copolymers, and polyalphaolefins, such are considered well known polymers in the art for providing flexible binder extrusions and it would have been well within the purview of one of ordinary skill in the art at the time of the invention to provide

any one of the claimed polymers known in the art, only the expected results would be attained.

9. Claims 1-10, 13-17, 22-32, 35, 38-41, 60, 72, 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) as applied to the claims above, and further in view of Marshall et al. (US Patent No. 5,503,891).

As to the claimed percentages of the magnetic composition, Bielek appears to disclose at least up to 90% magnetic particles. It is known in the art to provide at least up to 96% magnetic particles in magnetic compositions in order to provide a stronger magnetic force. For example, Marshall discloses an example of a magnetic assembly where the magnetic composition layer comprises between 60 and 96% magnetic particles (column 2, lines 15-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly in Bielek with known percentages in the art of magnetic particles in the magnetic composition in order to provide the desired amount of magnetic strength in the finished product as exemplified by Marshall, only the expected results would be attained.

As to claim 78, Bielek discloses a variety of known polymers for the magnetic composition. Marshall discloses it is known in the art to use an ethylene vinyl acetate copolymer as the binder in a magnetic assembly. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly in

Bielek with known thermoplastic polymers as the binder as exemplified by Marshall, only the expected results would be attained.

10. Claims 5 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and optionally further in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Rippingale et al. (US Patent No. 5,114,517).

As to claim 77, the limitations similar to claim 1 are rejected as discussed above with reference to claim 1. As to claims 5 and 77, Bielek discloses subjecting the extruded layer to a magnetic field, but does not disclose if this is done while the extruded layer is still at an elevated temperature. Rippingale discloses subjecting an extruded magnetic layer to a magnetic field in order to provide a magnetic effect in the assembly (column 3, lines 10-28). The magnetic assembly is subjected to a magnetic field while the magnetic composition is at an elevated temperature in order to allow the proper alignment of the magnetic particles while the material is still soft (column 3, line 20). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming a magnetic assembly as shown by Bielek by subjecting the assembly to a magnetic field while the extruded layer is at an elevated temperature in order to provide a magnetic effect in the assembly while the magnetic particles can still be aligned as shown by Rippingale.

As to the newly added limitation to claim 77 that the magnetic field is maintained until the magnetic layer cools, Rippingale discloses that a magnetic field is applied while the magnetic layer is still softened and maintained after the magnetic layer has cooled (column 3, lines 18-28). Clearly, it would have been obvious to one of ordinary skill in the art forming the magnetic assembly as shown in Bielek would maintain the magnetic field until the layer was cooled to ensure the magnetic properties formed by the magnetic field are stable within the layer.

11. Claims 17, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and optionally further in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Sawa (US Patent No. 4,022,701).

As to claim 17, Bielek discloses a variety of materials for the magnetic particles including ferrite. It is considered well known in the art to provide a variety of well known magnetic ferrite compositions for magnetic particles such as barium, strontium, or lead in thermoplastic binders as exemplified by Sawa (column 3, lines 8-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the magnetic assembly as shown in Bielek with well known magnetic particles for the magnetic composition as exemplified by Sawa, only the expected results would be attained.

As to claims 19 and 20, Bielek discloses a variety of polyolefins for use as the thermoplastic binder. While Bielek does not specifically disclose using a polyalphaolefin, such thermoplastic binders are considered well known and one of ordinary skill in the art would readily recognize using such compositions, only the expected results would be attained. For example, Sawa discloses the use of known polyalphaolefins as a binder for magnetic compositions. It is noted that applicant admits in the Specification on page 7 that it is common for the terms polyolefin and polyalphaolefin to be used interchangeably. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown by Bielek with known thermoplastic polymers such as polyalphaolefins as is considered well known in the art and further exemplified by Sawa, only the expected results would be attained.

As to claim 21, Sawa discloses it is known in the art to provide magnetic particles of a size less than 40 microns (column 2, lines 40-45). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the magnetic assembly as shown in Bielek with a known particle size for the magnetic particles in the magnetic composition as exemplified by Sawa, only the expected results would be attained.

12. Claims 33, 34, 36, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and optionally further

in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Charley (US Patent No. 6,153,279).

Bielek shows a method of forming a magnetic assembly for forming novelty items including a release layer as discussed above.

As to claims 33 and 34, it is considered well known in the art to adhere assemblies with release liners to articles such as magazines, books, food packages, beverage containers, envelopes or boxes. For example, Charley discloses it is known in the art to form magnetic assemblies with release layers where the assembly is adhered to an article with the use of an adhesive in order to provide such known novelty items to known articles such as boxes. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the release layer in the magnetic assembly of Bielek with adhesive to adhere to a well known article in order to provide the assembly to consumers as is considered well known in the art and further exemplified by Charley.

As to claims 36 and 37 it is considered well known in the art to provide a perforated overlamine over magnetic assemblies in order to protect the assemblies until the consumer removes the assembly from the article. For example, Charley discloses a magnetic assembly with a perforated overlamine (18; column 3, lines 5-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown in Bielek with a perforated overlamine in order to protect the assembly until the consumer removes it from an article as shown by Charley.

13. Claims 79 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and optionally further in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Gregory (US Patent No. 4,941,935), Christel (US Patent No. 5,676,791), and/or Thompson (US Patent No. 4,455,184).

Bielek does not specifically disclose the particular rate in which the magnetic layer is applied to the printable substrate layer. However, it would have been well within the purview of one of ordinary skill in the art to select the appropriate rate for the particular materials used, the end product requirements of thickness and adhesion, etc. Additionally, Gregory, Christel, and/or Thompson are cited to show that the claimed ranges of application rates are known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown by Bielek with an appropriate application rate as is considered well within the purview of one of ordinary skill in the art to select and as further shown by Gregory, Christel, and/or Thompson as being within the known ranges, only the expected results would be attained.

14. Claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverchotz et al. (US Patent No. 5,869,148) further in view of Rippingale et al. (US Patent No. 5,114,517).

Silverchotz discloses a process of forming a magnetic assembly by providing a magnetic hot melt composition (601) at an elevated temperature comprising at least one magnetic material and at least one thermoplastic polymer (column 2, lines 19-27; using a hot melt polymer; column 3, line 22), and directly applying the magnetic layer at an elevated temperature when it is pliable to a printable substrate layer (web 200) (the hot melt composition is coated onto the substrate layer). Silverchotz discloses the composition comprising 70% magnetic material and 30% polymer (column 3, lines 25-30)

Silverchotz discloses subjecting the magnetic layer to a magnetic field, but does not disclose if this is done while the extruded layer is still at an elevated temperature. Rippingale discloses subjecting an extruded magnetic layer to a magnetic field in order to provide a magnetic effect in the assembly (column 3, lines 10-28). The magnetic assembly is subjected to a magnetic field while the magnetic composition is at an elevated temperature in order to allow the proper alignment of the magnetic particles while the material is still soft (column 3, line 20). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming a magnetic assembly as shown by Silverchotz by subjecting the assembly to a magnetic field while the extruded layer is at an elevated temperature in order to provide a magnetic effect in the assembly while the magnetic particles can still be aligned as shown by Rippingale.

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9, 12, 14, 15, 27 of copending Application No. 10/274189. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in 10/274189 fully encompass the claim limitations of the instant application. As to whether the magnetic composition is a hot melt in claims 1, 72, 75 such would have been well within the purview of one of ordinary skill in the art particularly in view of the references cited above. As to the limitations in claims 2-17, 19-41, 60, 75-80, of the instant Application, these limitations would have been obvious in view of the references as cited above as known in the art, only the expected results would be attained.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Amendment

17. The declarations under 37 CFR 1.132 filed on January 17, 2005 are insufficient to overcome the rejections of the claims.

As to the Declaration by Scott Morling, there is insufficient nexus between the statements in the declaration and the claimed invention.

As to paragraph 4, the fact that a corporation has licensed the process of the claimed invention does not alone provide sufficient evidence that it is the non-obviousness of the claim limitations that caused the licensing agreement.

As to paragraph 5, the fact that the licensed sales have tripled between the 4th quarter of 2003 and the third quarter of 2004 is insufficient evidence that the commercial success is directly derived from the claimed invention and not other factors such as heavy promoting, advertising, shift in advertising, consumption by purchasers, etc. (see MPEP § 716, 716.03).

As to the Declaration by Thomas H. Quinn, such arguments are not persuasive.

As to paragraph 8 that argues that Bielek suggests the use of solutions, such is not considered persuasive. There is no suggestion in Bielek that the polymers used in the magnetic layer are solutions.

As to paragraph 9 that argues that the flexible carrier film in Bielek are heat sensitive and would not be conducive to direct hot melt coating, such argument is also not persuasive. The polymers cited as the substrate in Bielek are not considered to be so heat sensitive to prevent one of ordinary skill in the art from applying a hot melt to the substrate materials. It is noted that Bielek additionally discloses co-extruding the magnetic layer with the substrate layer, therefore elevated heating of the substrate material is not considered to cause deformation (column 3, lines 19-26). It is further noted that the reference Wade discloses extruding a polymer at elevated temperatures

onto substrates such as polyester film and other plastic films (column 1, lines 35-40; column 4, lines 55-61).

As to the arguments in paragraph 10 that the second adhesive layer in Bielek are all solution based adhesives and that a continuous application that combines a hot melt coating with a solution coating has never been seen by Mr. Quinn, such is irrelevant and non persuasive. The claims do not require nor exclude a second coating, therefore whether the second coating is a solution coating is irrelevant. Even if the second coating in Bielek were a solution coating, there is also no suggestion that the process in Bielek must be continuous. Even if the process were continuous in Bielek, it is well known in a variety of arts to providing coatings and processes to layers in a continuous manner with different rates of application; there are a multitude of ways to overcome the differing rates in the art of processing films. The fact that Mr. Quinn has never seen such a continuous process with differing rates of application is unpersuasive.

The declaration argues in paragraph 11 that the magnetic adhesive layer in Bielek is a solvent because of the parenthetical use of the term solids. Such is unpersuasive. There is no suggestion of solvent coating in Bielek. Bielek indicates that the methods of forming the product are by co-extrusion, extrusion coating, and laminating (column 3, lines 19-25). Additionally, it is noted that the reference to solids the declaration cites is in one example cited by Bielek and does not indicate that that is the only teaching of Bielek (for example, Bielek teaches co-extrusion, extrusion coating, and laminating). Even so, the indication that the magnetic layer includes 15 parts

(solids) of VITEL merely indicates that the 15 parts of the adhesive layer is in solid form, with no indication that a solution is ever made.

The Declaration argues that the technical data sheet for Vitel 3350 discloses that the intended use for Vitel is a solution in a solvent and not a hot melt resin. The attachment of a data sheet for Vitel 3350 is incomplete and misleading. Examiner has included copies of the web pages that include all the text of the Vitel adhesives. The web pages include the missing text that recites that Vitel resins "are available as extrudable and limited solubility coating resins; solution coating resins; solution adhesive resins; hot melt extrusion resins; and specialty modifiers."

Response to Arguments

18. Applicant's arguments filed January 17, 2005 have been fully considered but they are not persuasive.

Applicant argues on page 13 that extrusion does not inherently suggest elevated temperatures and that water based and solvent based systems may be applied by extrusion as well. Examiner is not persuaded by such arguments. Persons of ordinary skill in the art applying polymeric compositions such as those disclosed by Bielek would look to elevated temperature extrusion as is considered well known in the art as exemplified by the references above and particularly since Bielek suggests "co-extrusion, extrusion coating, and laminating". There is no suggestion in Bielek of solution coating and it is unclear how one of ordinary skill in the art reading Bielek as a whole would come to the conclusion that the extrusion coating is not at elevated temperatures in light of its alternative suggestion to "co-extrusion" and "laminating".

Applicant is also not addressing the additional secondary reference of Silvershotz which shows it is known to apply such magnetic layers with hot melt binders.

Applicant further argues on pages 13 to 14 that the example of Vitel in Bielek is a solution because of the recitation of (solids) and the web cite that discloses such resin as extrudable and limited solubility coating resins, solution adhesive resins, hot melt extrusion resin modifiers. As discussed above, this argument is unpersuasive. The characterization of the web cite is incomplete.

Applicants arguments on pages 14-15 of the second adhesive being a solution are unpersuasive and irrelevant to the claim limitations and the rejection.

Applicant argues on page 15 that Silverschotz suggests hot melts but for differing amounts. The amounts are shown by Bielek, the binders in Bielek are considered to be hot melts, and Silverschotz is cited to further show that such binders are known to be used as hot melts in magnetic layers.

Applicant argues on pages 12 and 17 that none of the references cited by the Examiner have provided evidence that such an assembly (the pad article of claim 75) is obvious, that if such an assembly were so obvious it would merit mentioning in the references, and that no evidence is provided to make a pad of magnetic assemblies. The rejection is based on the well known fact in packaging that products made in a production line are stacked and packaged for shipping by either shrink wrapping or binding one end with adhesive. This assertion of common knowledge in the art was first made in the Office Action filed October 3, 2003 and Applicant did not traverse the statements in the first response filed December 11, 2003. Consequently, Applicant has

acquiesced to the statements as indicated in the Office Action filed March 8, 2003 and such statements are now and have been considered admitted prior art (MPEP 2144.03). Even if this were not the case, the traversal in the remarks filed on January 17, 2005 are not proper nor sufficient to warrant citation of evidence of the well known statements. Applicant has not stated why the noticed fact is not considered common knowledge or well known in the art as required by MPEP 2144.03.

Applicant describes the references Marshall, Rippingale, Sawa, Charley on pages 19-24 but does not provide any arguments to the combination of the references in the arguments, consequently the Examiner is not providing a response for the description of the references.

Applicant argues on pages 26-27 that Gregory, Christel and/or Thompson do not disclose direct application of a hot melt at elevated temperatures to a printable substrate. Gregory, Christel, and/or Thompson are cited merely only to show that the claimed ranges of application rates are known in the art, the other limitations of the claims are met by the references as discussed above.

Applicant argues on page 29 that claim 77 has been amended to clarify that the magnetic assembly is permanently magnetized at an elevated temperature. This limitation is not in the claims.

Applicant argues on pages 30-31 that the declaration of Scott Morling provides evidence of commercial success and industry respect. As discussed above, the declaration does not provide sufficient evidence of the nexus between the claimed invention and the secondary considerations.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys JP Corcoran whose telephone number is (571) 272-1214. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gladys JP Corcoran
Primary Examiner
Art Unit 1733

GJPC